

REMARKS

Applicants respectfully traverse the rejections made in the outstanding Office Action.

The Office Action

Claims 1-20 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-20 also stand rejected under 35 U.S.C. §103(a) as being unpatentable over Junqua, et al. (U.S. Patent No. 6,314,398) in view of Kaizu, et al. (Publication No. U.S. 2004/0015989).

The Cited Kaizu Reference is NOT Prior Art

The cited Kaizu reference is a published U.S. patent application which is based upon an international PCT application (namely, Application No. PCT/JP01/08811). This PCT application was published by WIPO in the Japanese language. Accordingly, the cited Kaizu reference is only prior art as of its U.S. publication date, namely, January 22, 2004. Moreover, the corresponding published PCT application is only prior art as of its publication date, which is April 18, 2002. In either case, both dates are after by the filing of the present application. Accordingly, neither the cited reference (i.e., the published U.S. application) nor its corresponding published PCT application qualify as prior art with respect to the present application.

Notably, a published U.S. patent application based on an internationally filed application does not enjoy prior art status relating back to the filing date of the international application unless the international application was published in the English language. See, e.g., MPEP §706.02(f)(1) – subsection II, Example 5; and, subsection III, Chart I.

Significantly, PCT/JP01/08811 was published in Japanese as WO 02/23125. PCT/JP01/08811 was not published in English.

Accordingly, inasmuch as the cited Kaizu reference is not prior art with respect to the present application, the rejection of claims 1-20 under 35 U.S.C. §103(a) is hereby traversed.

The Present Application is Directed to Statutory Subject Matter

The rejection of claims 1-20 under 35 U.S.C. §101 is also erroneous and/or improper.

First, Applicants note that claims 11-20 are drawn to a service control point connected to a telephone system and a television system. Claim 11 expressly calls for query generating means, a database and searching means. Claim 12 recites a voice recognition module. Clearly, claims 1-20 are directed to statutory subject matter. These claims are not directed to a method that can be implemented by a human with a pencil and a piece of paper. In fact, these claims are not even method claims. Accordingly, the Examiner's reasoning is not even applicable to claims 11-20.

Second, as to claim 1, the Examiner suggests that the claimed steps of receiving, generating, searching and sending can be implemented by a human with a pencil and a piece of paper – Applicants disagree. For example, claim 1 calls for receiving a telephone call. Applicants cannot fathom how a human could use a piece of paper and pencil to receive a telephone call. Claim 1 also calls for sending search results to a television receiver box via a television system such that the search results are displayable upon a television operatively connected to the receiver box. Again, Applicants cannot fathom how a human would use a pencil and piece of paper to send anything over a television system. In any event, however, the Examiner's reasoning and/or basis for the 101 rejection has no rational relationship to the utility of an invention. On the contrary, as the Office Action itself points out, "utility" is a question of "practical application" and/or the production of "useful, concrete and tangible results."

It is well established that process and/or method claims are generally acceptable statutory subject matter. The specific apparatus or other means by which a process or method is implemented does not dictate whether the process or method produces useful, concrete and/or tangible results. There is no legitimate basis to reject a process or method claim merely because it can be implemented by a human using a pencil and paper.

In the present application, claims 1-10 are directed to a method with practical application and which produces a useful, concrete and tangible result. Claim 1 clearly has a practical application, e.g., the searching of television programming information and outputting the corresponding results. Claim 1 explicitly recites that results of the search are output so as to be viewable on a television. Accordingly, the expressly

recited output results are concrete and tangible. Moreover, the results are useful. They allow the television viewer to know what television programming is available that meets the particular search criteria. This is clearly a useful result.

Accordingly, insomuch as the present application is directed to statutory subject matter, the rejection of claims 1-20 under 35 U.S.C. §101 is hereby traversed.

CONCLUSION

For the reasons detailed above, it is respectfully submitted that all the claims in the application are in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to telephone the below signed at telephone number indicated.

Respectfully submitted,

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March 20, 2006

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